

**REMARKS/ARGUMENTS**

Claims 1-15 are pending in the present application. A new claim 16 has been added. Claims 1, 4-7, and 9-10 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Arsenault, 35 U.S.C. § 102(b) as being clearly anticipated by Ezell; and 35 U.S.C. § 102(b) as being clearly anticipated by Sugihara et al. Claim 2 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Arsenault in view of Etchen. Claims 3 and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ezell. Claims 11-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sugihara et al. Applicant traverses all rejections.

Claims 1, 4-7, and 9-10 have been rejected under 35 U.S.C. § 102 as being clearly anticipated by Arsenault Ezell, and Sugihara et al. Anticipation "requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee." Hoover Group, Inc. v. Custom Metalcraft, Inc., 66 F.3d 299, 302, 36 U.S.P.Q.2d 1101, 1103 (Fed. Cir. 1995). "[P]rior knowledge by others requires that all of the elements and limitations of the claimed subject matter must be expressly or inherently described in a single prior art reference." Elan Pharms., Inc. v. Mayo Foundation for Medical Educ. & Research, 304 F.2d 1221, 1227, 64 U.S.P.Q.2d 1292 (Fed. Cir. 2002) (citing In re Robertson, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950 (Fed. Cir. 1999); Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 1571 7 U.S.P.Q.2d 1057, 1064 (Fed. Cir. 1988)). "The single reference must describe and enable the claimed invention, including all claim limitations, with sufficient clarity and detail to establish that the subject matter already existed in the prior art and that its existence was recognized by persons

of ordinary skill in the field of the invention." Id. (citing Crown Operations Int'l, Ltd. v. Solutia Inc., 289 F.3d 1367, 1375, 62 U.S.P.Q.2d 1917, 1921 (Fed. Cir. 2002); In re Spada, 911 F.2d 705, 708 15 U.S.P.Q.2d 1655, 1657 (Fed. Cir. 1990)). See also PPG Indus., Inc. v. Guardian Indus. Corp., 75 F.3d 1558, 1566, 37 U.S.P.Q.2d 1618, 1624 (Fed. Cir. 1996) (emphasis added).

Claim 1 has been amended to add the limitation that "a support member slidably connected to the shaft at a first end of the support member with a releasable clamp." This amendment gains its support from the specification on page 3, lines 9-13. The Arsenault, Ezell, and Sugihara devices do not provide for a releasable clamp but instead, Arsenault provides for a clamp 40 that has bolts 32 inserted through holes 36 in the upper section of clamp 40 and are drawn tight by wing nuts 34 to secure the clamp 40 to the trimmer shaft 12. (Col. 3, lines 45-47). Similarly, Ezell provides for two types of clamps that may be used to clamp the various embodiments; a unitary clamp 42 that is constructed by bending an end of a bracket around a diameter sized so as to accommodate a shaft of a trimmer and forming a tab 44 on the end of the bracket and using a bolt, screw or other fastener to tighten clamp 42 on the trimmer shaft. (Col. 3, 42-51). The second clamp 48 is a two piece clamp 48 that has separate clamp portion 50 provided with two openings through which screws or bolts 52 are inserted, with corresponding openings provided in a bracket 54, thus when the fasteners 52 are tightened, the clamps is pulled tight against the shaft of the string trimmer. (Col. 3, lines 52-60). Thus, the Ezell patent shows the traditional nut and bolt type clamps that are not releasable. Sugihara et al. provides for a bracket 15 with an insert hole 22 and adjusting holes 23 that use a retaining

bolt 24 and a fastening nut 25 to secure the bracket 15 to the trimmer shaft. (Col. 5, lines 14-27). Thus, all three prior art references provide for a clamp member that is not releasable and thus, does not allow the support member to freely slide along the shaft of the trimmer. By being able to slide the clamp and therefore guard to a desired position on the shaft before use, the present invention provides the advantage of flexibility of positioning the guard along the shaft to allow a user to further adapt the guard 10 based on the landscape terrain and desired use. (See page 4, lines 15-18). Therefore, by having a releasable clamp the claimed invention has a mechanical advantage over the prior art references cited. Consequently, the anticipation rejection must be withdrawn. Additionally, claims 4 and 5 depend on claim 1 and for at least this reason should be considered in allowable form.

Independent claim 6 has been amended to add the limitation of claim 10 and now requires a guard for a grass trimming device "wherein the guard is positioned at a 90 degree angle to the shaft." Accordingly, claim 10 has been cancelled. The Arsenault patent does not provide for a guard that is positioned at a 90 degree angle to the shaft. Instead, the shield 20 is at a 90 degree angle with the ground. (See Fig. 1). Similarly, Ezell provides for a shield or barrier 20 that is held in an upright position so that the shield 20 is of vertical length with the ground. (Col. 2, lines 33-41). Additionally, the Sugihara device provides for a protection portion 18 that has a protection sheets 19A-19C that has vertical positions and thus is at a 90 degree angle with the ground and not the shaft. (Col. 7, lines 61-66). According to this invention because not all landscapes are flat having a guard member that is at a 90 degree angle with the ground instead of being at a 90 degree

angle with the shaft of the trimmer will cause the guard to not be in a position to provide maximum protection during the trimming process. (See page 1, lines 24-26). Thus, once again, the placing of the guard at a 90 degree angle to the shaft provides for a mechanical advantage and consequently each and every limitation of the claimed invention is not present in the prior art and therefore the anticipation rejection must be withdrawn. Claims 7, 9, and new claim 16 depend on claim 6 and for at least this reason are considered in allowable form.

Claim 2 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Arsenault in view of Etchen. Applicant asserts that the Examiner has failed to meet his burden of establishing a *prima facie* case of obviousness because the Etchen reference is not analogous art and should not be considered in an obviousness analysis. The references relied upon by the Examiner must either be in the field of the inventor's endeavor or reasonably pertinent to the specific problem with which the inventor was involved. In re Deminski, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986).

The Etchen reference relied upon by the Examiner is not in the Applicant's field of endeavor. When regarding the field of endeavor, the present invention deals particularly with handheld grass and weed cutters. In contrast, the Etchen patent is directed toward a fabric cutter. Etchen is not directed toward nor does it discuss handheld grass and weed cutters. Consequently, this reference relied upon by the Examiner is not in the field of the inventor's endeavor and should not be relied upon.

The Etchen reference also is not reasonably pertinent to the Applicant's problem. The Federal Circuit has clarified how

to determine whether a reference is reasonably pertinent to the particular problem in which the endeavor is involved as follows:

[a] reference is reasonably pertinent if ... it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem. ... if a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem. ... [i]f it is directed to a different purpose, the inventor accordingly would have had less motivation or occasion to consider it.  
In re Clay, 966 F.2d 656, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). (Emphasis added); See also MPEP § 2141.01(a).

According to the Applicant's specification, the purpose of the present invention is to provide "for a trimmer guard that will be sufficiently flexible to move in and around objects at different landscapes that at the same time will be able to be moved in varying directions to accommodate for trimming weeds." (Page 1, lines 27-31). This is accomplished in part by placing the guard on the trimmer at a 90 degree angle and making the guard out of brush bristles that are flexible and easily moved. The purpose of the Etchen reference is to "provide guards for fabric cutters of the type which are translated over the work on which the pattern has been marked or outlined or superimposed." (Col. 1, lines 4-6).

Thus, Etchen is directed to the problem of protecting fabric cutters from a cutting disc while cutting fabric and not to preventing grass and small rocks from being projected from the rotating head of the cutter towards an individual using a trimmer. Therefore, Etchen solves a different problem than the claimed invention. Consequently, one skilled in the art would have less motivation or occasion to consider the reference cited by the Examiner. Because the reference relied upon by the

Examiner is not in the field of the inventor's endeavor and is not reasonably pertinent to the specific problem in which the inventor is involved, the Etchen reference is not analogous and should not be considered in the obviousness analysis.

Even if the Etchen reference is considered analogous art the proposed combination does not disclose the invention as claimed. The teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. See In re Vacck, 997 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); MPEP § 2143. To establish a *prima facie* case of obviousness, all the claim limitations must be taught by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 57 C.C.P.A. 1029, 1032 (1970).

Claim 1 has been amended to require "a support member slidably connected to the shaft, a first end of the support member with a releasable clamp." The Etchen device does not provide for a releasable clamp that slidably connects the support member to a shaft. Instead, the Etchen device provides for a guard having side guard plates 9 that are fastened to brackets 13 and 14. These brackets are not attached to a shaft and thus, cannot be the support member as described in claim 1. Thus, the Etchen device does not provide for a support member slidably connected to the shaft at a first end of the support member with a releasable clamp as is required by the claim. As discussed earlier, Arsenault also does not provide for this claim limitation. Thus, when combined, the two references do not result in the invention as claimed and the obviousness rejection must be withdrawn.

Claims 3 and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ezell. A new limitation has been added to both independent claim 1 and 6 as discussed above, both of which are limitations not met by Ezell as discussed above. Consequently, because claim 3 depends on claim 1 and claim 8 depends on claim 6, for at least this reason each and every limitation of these claims are not met and both claims 3 and 8 are in allowable form.

Claims 11-15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Sugihara. According to the Examiner, "Sugihara shows the claimed invention except that the guard may not be considered to be a brush. This construction is very similar to a brush and it is therefore felt that using a brush would have been obvious. In other words, a brush is a mechanical equivalent to the guard of Sugihara and would be obvious to use therewith." (Office Action page 3). In order to rely on equivalents as a rational supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on Applicant's disclosure or the mere fact the components at issue are functional or mechanical equivalents. In re Scott, 323 F.2d 1016, 139 USPQ 297 (CCPA 1963). For example, in Scott, claims that were drawn to a hollow fiberglass shaft for archery and a process for the production thereof where the shaft differed from the prior art in the use of a paper tube as the core of the shaft as compared with the light wood or hardened foamed resin core of the prior art. The Court stated that components which are functionally or mechanically equivalent are not necessarily obvious in view of one another and in this case, the use of light wood or hardened foam resin core does not fairly suggest the use of a paper core. Id. (See also MPEP § 2144.06).

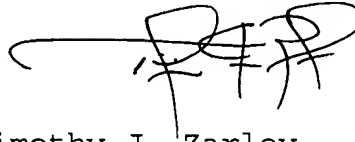
The Applicant submits that the Examiner has failed to meet the *prima facie* case of obviousness because the Examiner has not relied on equivalency that is recognized in the prior art. Specifically, the Examiner has not pointed to a piece of prior art that suggests that the shield seen in Sugihara will perform the same functions or be an equivalent of a brush as is required by independent claim 11. A brush uses elongated bristles that not only allow for the shield to negotiate around obstructions but also allows for air flow through the guard member 24 while restricting the flow of grass particles. (See page 4, lines 21-31). Sugihara does not suggest that its shield is able to negotiate around obstructions and at the same time has the same air flow characteristics of a brush. Thus, because the equivalency is not recognized in the prior art the Examiner has not provided a *prima facie* case of obviousness and the rejection must be withdrawn. Consequently, claim 11 is in allowable form and for at least the reason that claims 12-15 that depend on claim 11 are also in allowable form.

#### CONCLUSION

If any issues remain that may be expeditiously addressed in a telephone interview, the Examiner is encouraged to telephone the undersigned at 515/558-0200. All fees or extensions of time believed to be due in connection with this response are attached hereto; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-2098.

Application No. 10/784,056  
Docket No. P06711US0  
Reply to Office Action of November 2, 2004

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'T. Zarley', with a long horizontal flourish extending to the left.

Timothy J. Zarley  
Reg. No. 45,253  
ZARLEY LAW FIRM, P.L.C  
Capital Square  
400 Locust Street, Suite 200  
Des Moines, IA 50309-2350  
Phone No. (515) 558-0200  
Fax No. (515) 558-7790  
Customer No. 34082  
Attorneys of Record

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